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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,600	09/02/1999	SHINICHI KANEMATSU	35.C13795	4211
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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,600

Applicant(s)

KANEMATSU, SHINICHI

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16-26, 31 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-26, 31 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/9/06 has been entered.

Response to Amendment

2. Applicant's amendment was received on 3/9/06, and has been entered and made of record. Currently, **claims 1-11, 16-26, 31 and 36** are pending.

Response to Arguments

3. By the amendment, the claim Objection of claims 1 and 16 has been withdrawn.

4. Upon review of the references of *Tashima* (U.S. Patent No. 6,567,178) and *Bramall* (U.S. Patent No. 5,771,101), which were cited in the Office Action dated 10/4/05 under 35 U.S.C. 103(a), as being obvious, the examiner notes that the references can still be interpreted to maintain the rejections, as currently amended.

In response to applicant's argument regarding the rejection of claim 1, wherein on pages 22-23, the applicant explains how the current invention differs from the teachings of *Tashima* and *Bramall*. Particularly, the applicant states that

[n]othing in *Tashima* and *Bramall*, whether taken either separately or in any permissible combination (if any), would teach or suggest performing an authentication process for entered user information to determine whether a first operating instruction is authorized for the user, and when the user is authenticated, transmitting a second operating instruction and the entered user information to a different image processing apparatus for another authentication process, and when the user is again authenticated, performing the second operating instruction after the first operating instruction is performed. (page 23)

Examiner respectfully disagrees. As shown in fig. 8 of *Tashima*, before the actual transmission of the scanned image (step 5), the transmitting fax 102 sends the user information to the receiving fax 100 to determine whether the user is authorized to use the receiving fax 100. Upon receiving the authentication results from the receiving fax 100 (step 4), the transmitting fax 102 sends the scanned image to the receiving fax 100 for printing the scanned image (col. 1, lines 31-62). The only claim limitation that is not taught by *Tashima* is that *Tashima* does not explicitly disclose whether the transmitting fax 102 checks to see if the user is authorized to use the transmitting fax for scanning the image. In other words, there is no teaching as to what happens before step 1 of fig. 8. *Bramall*, the same field of endeavor of the secure facsimile transmission, teaches the method of securing the transmitting fax machine from unauthorized users. As disclosed in col. 5, lines 46-55, the user can input the user information in the transmitting fax machine to authorize the user to use the fax machine. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to

implement the security system of *Bramall* into the transmitting fax 102 of *Tashima*. The suggestion/motivation for doing so would have been to provide the security not only at the receiving fax 100 but also at the transmitting fax 102 as well. The combination of *Tashima* and *Bramall*, therefore, would certainly disclose each and every claim limitations recited in claim 1.

Independent claims 6, 11, 16, 21, 26, 31 and 36 recite features which are similar in many relevant respect to those discussed above with respect to claim 1 and therefore are also believed to be not patentable over the cited references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-11, 16-26, 31 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tashima* in view of *Bramall*.

5. With respect to claim 1, *Tashima* discloses (fig. 8) an image processing apparatus (transmission requester fax 102) that performs an image processing service provided by a first operating instruction about image processing (scanning) and a second operating instruction about image processing for a different image processing apparatus (fax mail apparatus 100 & col. 2, lines 51-59), comprising:

input means for entering user information and the first operating instruction for said image processing apparatus (col. 1, lines 31-49);

transmission means for transmitting to the different image processing apparatus the second operating instruction and the user information entered by said input means (col. 1, lines 31-49 & col. 2, lines 51-59);

second authentication means for obtaining from the different image processing apparatus results of an authentication process, performed for the user information received from said transmission means, to determine whether the second operating instruction is authorized for the user on the different image processing apparatus (col. 1, lines 50-57); and

determination means for employing the results obtained by said second authentication means to determine whether the user is to be permitted to use said image processing apparatus in conjunction with the different image processing apparatus to perform the first and second operating instruction of the image processing service (col. 1, lines 57-62),

wherein the first operating instruction is performed by said image processing apparatus and the second operating instruction is performed by the different image processing apparatus after the first operating instruction is performed (col. 2, lines 51-59).

Tashima, however, does not disclose expressly the *registration mean for registering registration information for a user who is authorized to use said image processing apparatus*;

first authentication means for employing the registration information registered by said registration means and the user information entered by said input means to determine whether the first operation instruction is authorized for the user, and

transmission means for, based on the results obtained by said first authentication means, transmitting to the different image processing apparatus the second operating instruction and the user information entered by said input means.

Bramall, the same field of endeavor of the facsimile (col. 1, lines 3-25), discloses an image processing apparatus that performs an image processing service provided by a first operating instruction about image processing (scanning in col. 2, lines 27-30) and a second operating instruction about image processing for a different image processing apparatus (destination fax), comprising:

registration mean for registering registration information for a user who is authorized to use said image processing apparatus (col. 5, lines 22-26);

input means for entering user information and the first operating instruction for said image processing apparatus (col. 5, lines 46-55);

first authentication means for employing the registration information registered by said registration means and the user information entered by said input means to determine whether the first operation instruction is authorized for the user (col. 5, lines 46-55); and

transmission means for, based on the results obtained by said first authentication means, transmitting to the different image processing apparatus the second operating instruction and the user information entered by said input means (col. 5, lines 46-55),

wherein the first operating instruction is performed by said image processing apparatus and the second operating instruction is performed by said different image processing apparatus after the first operating instruction is performed (col. 5, lines 46-55).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the first authentication means of Bramall into the facsimile system of Tashima.

The suggestion/motivation for doing so would have been to provide a data security system at the transmitting side.

Therefore, it would have been obvious to combine Tashima with Bramall to obtain the invention as specified in claim 1.

6. With respect to claim 2, Tashima discloses the image processing apparatus, wherein the registration information and the user information each includes at least a user ID and a password (col. 1, lines 40-41). Also, read col. 5, lines 46-55.

7. With respect to claim 3, Tashima discloses the image processing apparatus, further comprising:

scanning means for reading a document,

wherein the second operating instruction is an instruction for printing image data read by said scanner means using a printer function of the different image processing apparatus (col. 3, lines 1-12).

Further, Bramall discloses a scanner for reading a document (scanning in col. 2, lines 27-30).

8. With respect to claim 4, Tashima discloses the image processing apparatus, further comprising:

scanning means for reading a document,

wherein the second operating instruction is an instruction for storing, in a predetermined area, image data read by said scanner means using a storage function of the different image processing apparatus (col. 7, lines 56-60 & col. 9, lines 49-51).

9. With respect to claim 5, Tashima discloses the image processing apparatus, further comprising:

scanning means for reading a document,

wherein the second operating instruction is an instruction for transmitting, to a predetermined destination, image data read by said scanner means by using a facsimile transmission function of the different image processing apparatus (fig. 10).

10. With respect to claim 11, 16, 26, 31, arguments analogous to those presented for claim 1, are applicable.

11. With respect to claim 17, arguments analogous to those presented for claim 2, are applicable.

12. With respect to claim 18, arguments analogous to those presented for claim 3, are applicable.

13. With respect to claim 19, arguments analogous to those presented for claim 4, are applicable.

14. With respect to claim 20, arguments analogous to those presented for claim 5, are applicable.

15. With respect to claim 6, Tashima discloses an image processing apparatus (fax mail apparatus 100 & col. 2, lines 51-59) that performs, in cooperation with a different image processing apparatus (transmission requester fax 102) that performs a first operating instruction about image processing (scanning), an image processing service provided by a second instruction about image processing comprising:

registration means for registering registration for a user who is permitted to use said image processing apparatus (col. 1, lines 29-30);

reception means for receiving user information and the second operating instruction for said image processing apparatus from a different image processing apparatus (col. 1, lines 31-49 & col. 2, lines 51-59);

authentication means for employing the registration information registered by said registration means and the user information received by said reception means to determine whether the user is an authorized user (col. 1, lines 50-57); and

determination means for employing results obtained by said authentication means to determine whether the second operating instruction received by said reception means is to be accepted (col. 1, lines 57-62),

wherein the first operating instruction is performed by said different image processing apparatus and the second operating instruction is performed by said image

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processing apparatus after the first operating instruction is performed (col. 2, lines 51-59).

Tashima, however, does not teach expressly that the second operating instruction is received after the first operating instruction is authenticated to be performed on the different image processing apparatus.

As set forth above, Bramall, the same field of endeavor of the facsimile (col. 1, lines 3-25), discloses a different image processing apparatus that performs an image processing service provided by a first operating instruction about image processing (scanning in col. 2, lines 27-30) and a second operating instruction about image processing for an image processing apparatus (destination fax), comprising:

registration mean for registering registration information for a user who is authorized to use said different image processing apparatus (col. 5, lines 22-26);

input means for entering user information and the first operating instruction for said different image processing apparatus (col. 5, lines 46-55);

authentication means for employing the registration information registered by said registration means and the user information entered by said input means to determine whether the first operation instruction is authorized for the user (col. 5, lines 46-55); and

transmission means for, based on the results obtained by said first authentication means, transmitting to the image processing apparatus the second operating instruction and the user information entered by said input means (col. 5, lines 46-55),

wherein the first operating instruction is performed by said different image processing apparatus and the second operating instruction is performed by said image processing apparatus after the first operating instruction is performed (col. 5, lines 46-55).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the authentication means of Bramall into the facsimile system of Tashima.

The suggestion/motivation for doing so would have been to provide a data security system at the transmitting side.

Therefore, it would have been obvious to combine Tashima with Bramall to obtain the invention as specified in claim 6.

16. With respect to claims 7 and 22, arguments analogous to those presented for claim 2, are applicable.

17. With respect to claims 8 and 23, arguments analogous to those presented for claim 3, are applicable.

18. With respect to claims 9 and 24, arguments analogous to those presented for claim 4, are applicable.

19. With respect to claims 10 and 25, arguments analogous to those presented for claim 5, are applicable.

20. With respect to claims 21 and 36, arguments analogous to those presented for claim 6, are applicable.

Contact Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
April 5, 2006

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Art Unit 2625

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